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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,610	03/14/2001	Robin E. Wright	56495US1A002	2868

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James J. Trussel, Esq.  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,610

Applicant(s)

WRIGHT, ROBIN E.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to method of detackifying an edge face of a roll of adhesive tape, classified in class 156, subclass 60+.
- II. Claims 19-35, drawn to a roll of adhesive tape, classified in class 428, subclass 343.

2. The inventions are distinct, each from the other because:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process such as coat a varnish or lacquer on the edge face.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Allison Johnson on May 30, 2001 a provisional election was made with traverse to prosecute the invention of II, claims 19-35. Affirmation of this election must be made by applicant in replying to this Office

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action. Claims 1-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP SHO 50-10353 in view of JP 60027628 A (Derwent Abstract).

For claims 19, 21-26, 29-31, and 33, JP '353 is directed to form a cured layer on the edge face of a roll of pressure-sensitive adhesive tape (page 2, paragraph 1 and 2). JP '353 teaches that edge face of roll of pressure-sensitive adhesive is coated with a solution containing a crosslinkable photosensitizer, or a crosslinkable photosensitizer and a photoactive crosslinking agent and a vinyl-based polymer, then exposed to an irradiation to form a cured layer (page 4, paragraph 3). JP '353 lacks the specific teaching of using a radiation curable acrylate oligomer, polyetheracrylate oligomer, monomer, or a combination of radiation curable materials. JP '628 is related to a photo-curable adhesive of monomer and/or oligomer type, and contains photoinitiator such as benzophenone (claim 31), etc. JP '628 teaches that suitable photo-curable acrylate monomers included ~~ethyl~~(metha)acrylate, glycidyl(metha)acrylate (claim 26), a combination of diethyleneglycol diacrylate and ethylenethioglycol (claim 25), etc., and

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acrylate oligomers such as epoxyacrylate, urethane acrylate, polyester acrylate, and polyetheracrylate (claims 19, 21-24, 29-30, 34-35), etc. Note also as evidence of the state of the art cited in Concise Encyclopedia of Polymer Science and Engineering: "Photoinitiated radical polymerization of acrylate resins (monomers and oligomers) is widely employed commercially." (Page 729, column 2, lines 5-7). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to use various alternative photo-curable acrylate oligomers and monomers, such as the acrylate monomers, oligomers and polyetheracrylate taught by JP '628 to modify the coating solution of JP '353, motivated by desire to obtain a solvent-free photo-curable coating.

With respect to claim 20, JP '353 does not expressly teach the composition of the radiation curable adhesive, however, in the absence of unexpected results, it is believed that suitable composition ratio is either ~~an~~ inherent or an obvious optimization.

With respect to claims 27-28, matting agent such as silica is a common and well-known additive to one of ordinary skill in the art for modifying a coating glossiness. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to include the matting agent in a coating composition, motivated by the desire to control the surface glossiness.

With respect to claim 32, JP '353 does not state the coating remains adhered to the unwounded tape. However, it is believed that for a thin detackfying coating, it is an inherent property for the coating to break at the tip of stress concentration, and consequently remains with the unwounded tape.

With respect to claims 34 and 35, in Application Example 1 (page 9, paragraph 6), JP '353 teaches applying the radiation curable coating onto both edge faces of an adhesive roll, and in Application Example 2 (page 10, paragraph 1), the coating is applied to one edge face only. Therefore, it would have also been obvious to one of ordinary skill in the art to apply a discontinuous coating only to suitable area on the edge surface, motivated by the desire to reduce the cost.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making radiation curable adhesive.

US 5734002 to Reich et al.

US 5070121 to Hinterwaldner et al.

It is noted that the reference by Reich et al. specifically teaches polyetheracrylate containing amine functionality as photo-curable material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
VSC  
June 5, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*